C2   44. (Amended) The apparatus according to claim 43, wherein the probing operator includes a data mining query.

C3   61. (Amended) The method according to claim 58, wherein the predefined criteria includes at least one condition.

C4   64. (Amended) The method according to claim 63, wherein the probing operator includes a data mining query.

Please add new claims 84 and 85, as follows:

--84. (New) The apparatus according to claim 38, wherein the at least one event is detected on the network.

C5

85. (New) The method according to claim 58, wherein the at least one event is detected on the network.--.

REMARKS

I.   **GENERAL**

Claims 41, 44, 61 and 64 have been amended merely correctly recite the subject matter of provided therein. Attached hereto, please find a marked-up version of

the claim changes made to the by the current amendment. The attached pages with these claim changes marked appropriately is captioned as "**VERSION WITH MARKINGS TO SHOW CLAIM CHANGES MADE**". Claims 84 and 85 have been added to the above-identified application. Accordingly, claims 38, 39, 41-59 and 61-85 are now under consideration in the present application. Applicants respectfully submit that no new matter has been added.

II. THE REJECTIONS UNDER 35 U.S.C. §§ 102(e) AND 103(a) SHOULD BE WITHDRAWN

Claims 38, 39, 41-47, 50-59, 61-67 and 70-83 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,893,091 issued to Hunt et al. (the "Hunt Patent"). The Examiner also rejected claims 48, 49, 68 and 69 under 35 U.S.C. § 103(a) as being unpatentable over the Hunt Patent, in view of A. Prasad Sistla et al., "Temporal Conditions and Integrity Constraints in Active Database Systems" (the "Sistla Publication"). It is respectfully asserted that pending independent claims 38, 42, 52, 53, 58, 62, 72, 73, 78, 80, 82 and 83 and the claims which depend from these independent claims are in no way taught or suggested by the Hunt Patent, taken alone or in combination with the Sistla Publication for at least the reasons as set forth below.

In order to render a claim anticipated under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way. See Lindeman Machinenfabrik v. Am Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103,

not only must the prior art teach or suggest each element of the claim, the prior art must

also suggest combining the elements in the manner contemplated by the claim. See

Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir.), cert. denied

111 S.Ct. 296 (1990); see In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990).

Applicants' invention, as recited in independent claim 38, relates to an

apparatus for monitoring information on a network. The apparatus comprises, *inter alia*:

> a storage device storing a predefined criterion, and having a monitoring module thereon; and
>
> **a processing device executing the monitoring module to transmit at least one instruction to the network, the at least one instruction requesting a performance of a monitoring operation to monitor the information on the network as a function of the predetermined criterion, the processing device is adapted to receive data from the network based on at least one result of the monitoring operation ... .**

Independent claims 42, 52, 53, 80 and 83 relate to apparatuses which recite similar

subject matter, and independent claims 58, 62, 72, 73, 78 and 82 relate to method also

including similar recitations.

The Hunt Patent relates to a system and method for managing and

distributing information in the form of alerts that are divided into a keyword-part and an

argument-part over a data network. (See Hunt Patent, column 4, lines 38-44). The

system and method are based on a server-push model, and deliver user notifications of

new information posted by participating content providers (i.e., Timely Information

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Providers) via IP Multicast. (See Id., column 4, lines 44-47). In particular, the Timely

Information Server 4 sends the alert over the computer network using the IP Multicast.

The alert is received by subscriber clients 8a, 8b, 8c which compare the keywords in the

alert to their local keyword profiles 10a, 10b, 10c using a predetermined logical

(Boolean) expression, and display the alerts which satisfy the expression. (See Id.,

column 7, line 63 to column 8, line 3).

As described in the Hunt Patent, the Timely Information Providers 2d send

information to the Timely Information Server 4, or the Timely Information Server 4 can

go out and collect the information from the Timely Information Providers 2d. (See Id.,

column 8, lines 8-12). The Timely Information Server 4 analyses the incoming

information, and compares it with its Keyword Dictionary 6 to create an alert, which is

sent over the network. (See Id., column 8, lines 12-15). The alert is received by the

client computer 8d which compares the keywords in the alert to their local keyword

profile 10d using the logical expression. If the criteria of expression is satisfied, the

client computer 8d notifies the user of the presence of the alert 12. (See Id., column 8,

lines 15-20). At the same time the client 8d receives the information from the Timely

Information Providers 2d, a tracking information packet is sent 15 to the Timely

Information Server 4 specifying that the user/client has acted upon the received alert.

(See Id., column 8, lines 28-31). According to the Hunt Patent, a Branded Information

Server 20 (which post new content on their Internet Servers) sends the alert over the

network via the IP Multicast to the client 8a who has subscribed (registered) to receive alerts from a Branded Information Server 18. (See Id., column 8, line 52-55).

A.   CLAIMS 38, 39, 41, 42, 45, 46, 52, 53, 58, 59, 61, 62, 65, 66 AND 72-83

Applicants respectfully assert that the Hunt Patent, taken alone or in combination with the Sistla Publication, does not teach or suggest, much less disclose an apparatus or method for monitoring information on a network in which, *inter alia*, *a monitoring module is executed to transmit at least one instruction to the network*, as explicitly recited in independent claims 38, 42, 52, 53, 58, 62, 72, 73, 78, 80, 82 and 83 of the above-identified application. In the Office Action dated May 2, 2001, the Examiner alleges that the Hunt Patent teaches this limitation by equating it to "client registrations [by the client 8a] to receive alerts ... [in] col. 8, lines 52-55 [of the Hunt Patent]." (See Office Action dated May 2, 2001, page 3, line 1).

First, it is respectfully submitted that the Hunt Patent lacks any enabling disclosure regarding how the client 8a *registers* to receive alerts. Indeed, the Hunt Patent merely indicates the end result, and not the way the registration is actually performed. By reading the disclosure of the Hunt Patent, one having ordinary skill in the art is left guessing as to how the client 8a can register to receive the alert in the Hunt Patent. It follows that one having ordinary skill in the art would not be able to determine what occurs during and after such registration by the client 8a. For example, the conventional registration techniques are generally one-time passive actions, as

opposed to the monitoring action (which is preferably active) that is recited in Applicants' claimed invention.

Second, Applicants respectfully assert that the Hunt Patent does not teach or suggest, much less disclose that this supposed registration by the client prompts an execution of any *monitoring module*, much less that by executing the monitoring module, at least one instruction is transmitted **to the network**. In particular, the disclosure of the Hunt Patent explicitly provides that the clients 8a, 8b, 8c receive the alerts, and compare the keywords in the alerts to their local keyword profiles 10a, 10b, 10c using a predetermined logical (Boolean) expression and display the alerts which satisfy the expression. (See Hunt Patent, column 7, line 63 to column 8, line 3). Thus, the clients 8a, 8b, 8c of the Hunt Patent only receive the alerts, and perform the comparison of these alerts locally (which was apparently equated by the Examiner to the monitoring operation). However, these clients 8a, 8b, 8c *do not* execute any monitoring module which is executed to transmit the instruction, *especially to the network*.

It follows that the Hunt Patent does not teach or suggest, much less disclose that **the instruction requests a performance of a monitoring operation to monitor the information on the network as a function of a predetermined criterion**, as also recited in independent claims 38, 42, 52, 53, 58, 62, 72, 73, 78, 80, 82 and 83. In addition, because the Hunt Patent does not teach or suggest the above-mentioned *monitoring operation* recited in Applicants' independent claims, the Hunt Patent also

does not teach or suggest that the **data is received from the network based on at least one result of the monitoring operation**, as also recited in the independent claims. The Sistla Publication does not cure at least the above-described deficiencies of the Hunt Patent to teach or suggest Applicants' invention as recited in independent claims 38, 42, 52, 53 58, 62, 72, 73, 78, 80, 82 and 83.

In addition, with respect to claims 42 and 62, these independent claims recite that **the information includes at least one event,** and that **the monitoring operation is performed by monitoring for the event on the network**. In the Office Action dated May 2, 2001, the Examiner apparently equates the keyword profile of the Hunt Patent (which is defined in terms of a Boolean expression) to the event of Applicants' claimed invention recited in independent claims 42 and 62. The Examiner also believes that the Hunt Patent teaches that the monitoring operation is performed by monitoring the event on the network. (See Office dated May 2, 2001, page 4, lines 7-10). Applicants respectfully disagree, and submit that the keyword of the Hunt Patent **cannot be equated** to the event as recited in independent claims 42 and 62 of the above-referenced application. The reason for this is that in the Hunt Patent, the keyword is a static (i.e., non-changeable) part of the condition, while the event of Applicant's claimed invention is a dynamic (i.e., changeable) part of the condition.

With respect to claims 39, 41, 45, 46, 59, 61, 65, 66, 74-77, 79 and 81, these claims depend from at least one of the independent claims described above. Thus, the arguments discussed above with respect to independent claims 38, 42, 52,

53, 58, 62, 72, 73, 78, 80, 82 and 83 also apply to claims 39, 41, 45, 46, 59, 61, 65, 66, 74-77, 79 and 81.

B. CLAIMS 43, 44, 47, 63, 64 AND 67

Claims 43, 44 and 47, and claims 63, 64 and 67 depend from independent claims 38 and 58, respectively. Accordingly, the arguments presented above for independent claims 38 and 58 apply equally to claims 43, 44, 47, 63, 64 and 67.

With respect to claims 43 and 63, these claims recite that **a THEN portion (of a rule-based criteria) includes a probing action which has at least one probing operator.** In the Office Action, the Examiner equates the ruled-based criteria of Applicant's claimed invention to a notification criteria of the Hunt Patent. (See Office Action dated May 2, 2001, page 4, lines 15-16). However, this notification criteria of the Hunt Patent uses a predetermined logical (Boolean) expression. Therefore, the "THEN" portion of the notification criteria of the Hunt Patent is a Boolean expression (i.e., either 0 or 1). In clear contrast to the teachings of the Hunt Patent, independent claims 43 and 63 explicitly recite that the THEN portion includes a ***probing action***. Applicants respectfully assert that this recited probing action cannot be equated to a mere Boolean expression of the Hunt Patent. Thus, at least for this additional reason and the reasons presented above, the Hunt Patent in no way teaches or suggests, much less discloses the subject matter recited in claims 43 and 63.

With respect to amended claims 44 and 64, these claims depend from claims 43 and 63, respectively. Accordingly, the arguments provided above for claims 43 and 63 are applicable to claims 44 and 64. In addition, amended claims 44 and 64 recite that **the probing operator includes a data mining query**. Applicants respectfully asserts that there is absolutely no disclosure in the Hunt Patent which teaches that the probing operator includes a *data mining query*. Thus, at least for this additional reason and the reasons presented above, the Hunt Patent in no way teaches or suggests, much less discloses the subject matter recited in amended claims 44 and 64.

With respect to claims 47 and 67, these claims depend from claims 43 and 63, respectively. Accordingly, the arguments provided above for claims 43 and 63 are applicable to claims 47 and 67. In addition, claims 47 and 67 recite that **an atomic condition (of a complex condition of the IF portion) includes at least one literal portion**. In the Office Action, the Examiner equates the literal portion of Applicants' claimed invention to Boolean operators of the Hunt Patent. (See Office Action dated May 2, 2001, page 5, lines 7-8). Applicants respectfully assert that the literal portion recited in these claims is a term of the art of logic programming and databases, which means either a negated or a non-negated predicate (e.g., a relation in a relational database). Accordingly, such literal portion of Applicants' claimed invention *cannot* be equated to a mere Boolean operator of the Hunt Patent. Thus, at least for this

additional reason and the reasons presented above, the Hunt Patent in no way teaches or suggests, much less discloses the subject matter recited in claims 47 and 67.

Again, the Sistla Publication does not cure the above-described deficiencies of the Hunt Patent, nor does the Examiner contends that it does.

C.   SUMMARY

Accordingly, the Hunt Patent, taken alone or in combination with Sistla Publication, does not teach or suggest, much less disclose the subject matter recited in independent claims 38, 42, 52, 53, 58, 62, 72, 73, 78, 80, 82 and 83 and the claims which depend therefrom. Therefore, an affirmation of patentability is respectfully requested for pending claims 38, 39, 41-59 and 61-83.

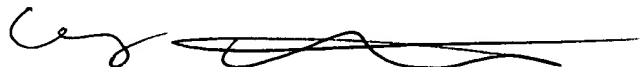## III.   NEW CLAIMS 84 and 85

New claims 84 and 85 are presented to cover further aspects of Applicants' invention. Support for new claims 84 and 85 can be found throughout the specification and in the drawings. New claims 84 and 85 depend from independent claims 38 and 58, respectively, and therefore include the recitation thereof. Accordingly, for at least the reasons presented above, Applicants respectfully submit that claims 84 and 85 are allowable over the Hunt Patent, taken alone or in combination with Sistla Publication.

IV.   <u>CONCLUSION</u>

In light of the foregoing, Applicants respectfully submit that pending claims 38, 39, 41-59 and 61-85 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: 11 July 2001

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VERSION WITH MARKINGS TO SHOW CLAIM CHANGES MADE

41. (Amended) The apparatus according to claim 38, wherein the [information] predefined criteria includes at least one condition.

44. (Amended) The apparatus according to claim 43, wherein the probing operator includes [at least one of:

a particular query,]

a data mining query[, and

a further condition which provides the information based on at least one of the WHEN portion and the IF portion].

61. (Amended) The method according to claim 58, wherein the [information] predefined criteria includes at least one condition.

64. (Amended) The method according to claim 63, wherein the probing operator includes [at least one of:

a particular query,]

a data mining query[, and

a further condition which provides the information based on at least one of the WHEN portion and the IF portion].